

REMARKS

Applicants elect with traverse the invention of Group I, corresponding to Claims 1-5. Applicants do not traverse the restriction requirement with respect to the invention of Group II, corresponding to Claims 6-11, which have been cancelled.

Of pending Claims 1-5 and 12-30, Claims 1 and 12 are independent and independent Claim 21 has been amended to depend from Claim 1. Added Claim 30 depends from Claim 1.

The restriction of Groups I, III and IV as related to combinations and sub-combinations is not understood, as each of Groups I, III and IV are believed directed to the same "combination". None of the claims are believed directed to a sub-combination.

Applicants respectfully disagree based on MPEP §806.05(a) which defines a sub-combination as a part of a combination. MPEP §806.05(c)(II)(B) indicates that two combination claims AB_{br} and AB_{sp}, which provide broad and more specific features respectively, would be grouped together for examination. A sub-combination B_{sp} may be used to obtain a restriction requirement. In particular, independent Claims 1 and 12, along with original Claim 21, are believed to be combination claims with some of the features thereof varying in scope from broad B_{br} to more specific B_{sp}, and none of these claims are a sub-combination or merely part of the other.

As to Group I (Claims 1-5) and Group III (Claims 12-20), it is noted that both of these Groups include quite similar preambles, as well as the same basic elements of a shaft, a coupling and a transponder with a solid state chip. Claim 1 more broadly defines an accessory by reciting a coupling, while Claim 12 more specifically defines a coupling by reciting a drive hub, an outer hub and a seal. Thus, both Claims 1 and 12 are combination claims that are related as AB_{br} (Claim 1) and AB_{sp} (Claim 12) and thus should be grouped and examined together.

As to Groups I (Claim 1) and IV (Claim 21), here again it is believed that these claims are in fact two combination

claims having similar features. More specifically, Claim 1 and original Claim 21 have similar preambles as both are directed to an accessory.

Amended Claim 21, which now depends from Claim 1, emphasizes features of the "coupling" recited in Claim 1. Thus, rather than providing a new element or feature, Claims 21-29 specifically expand on features already recited in Claim 1.

In conclusion, there is believed to be no claim in any of Groups I, III and IV that is only directed to a sub-combination. Instead, Groups I, III and IV are each directed to an accessory for use with a powered surgical tool or handpiece. Each of Groups I, III and IV then recite structure of the accessory. Group I would correspond to AB_{br} as set forth in MPEP §806.05(c) and Groups III and IV presumably would correspond to AB_{sp}. Thus no claim is directed to a sub-combination. As such, withdrawal of the restriction requirement with respect to Groups I, III and IV and examination of Claims 1-5 and 21-30 is requested.

Examination of all of these claims together is not believed to present a serious burden of examination since it is noted that all of Groups I, III and IV are classified in Class 606, in sub-classes that are directly associated with each other, as sub-classes 170 and 180 fall under sub-class 167. Presumably, as part of any search in sub-classes 170 or 180, it seems that broader sub-class 167 would also be reviewed. Moreover, the inventions of Groups III and IV are both classified in sub-class 180. Thus inventions III and IV clearly require the same basic search and should be examined together. Therefore it is unclear how searching for the inventions would provide a burden. Hence, withdrawal of the restriction requirement between Groups I, III and IV is requested as no unnecessary search is required.

Further, Claims 21-30 depend from Claim 1 and are believed directed to the same invention. So at a minimum,

examination of Claims 21-30 with the invention of Group I (Claims 1-5) is respectfully requested.

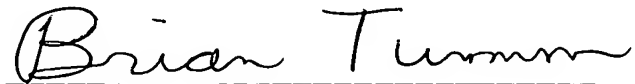
Page 3, first paragraph of the Office Action states that invention I "is a sub-combination as an electrical conductor is not required by Invention I". This statement is not understood, as Claim 1 recites a transponder that corresponds to both the accessory identification assembly in Claim 12 having a coil and to the transponder having a coil recited in original Claim 22 (Group IV), which now depends from Claim 1. Since the electrical conductor is a part of the transponder recited in Claim 1, the electric conductor recited in Group IV is B_{sp} with respect to the transponder B_{br} of Claim 1.

Page 3, second paragraph of the Office Action states that "the combinations as claimed does not require the particulars of the sub-combination as claimed because invention IV does not require RFID and a coil". This statement is not understood, as each independent claim need not recite each feature in the same detail. The RFID and coil are recited in dependent Claim 22 as elements of the transponder previously recited in Claim 21. Thus the RFID and coil of Claim 22 are not a new element, but further specify features of the transponder B_{br} recited in original Claim 21.

For the above reasons, Applicants ask for reconsideration and examination of Claims 1-5 and 12-30.

An action on the merits is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, reading "Brian Tumm". The signature is written in dark ink and is positioned above a horizontal line.

Brian R. Tumm

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